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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,620	09/29/2000	Daniel Rodman Hicks	ROC920000200	9570

7590 02/19/2004

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Houston, TX 77056-6582

EXAMINER
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KISS, ERIC B

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 02/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/675,620

Applicant(s)

HICKS, DANIEL RODMAN

Examiner

Eric B. Kiss

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The reply filed January 23, 2004, has been received and entered.

During a telephone conversation with Gero G. McClellan (Reg. 44,227) on February 10, 2004, it was confirmed that a typographical error had been made in the amendment on page 2. Instead of canceling claims 1-22 as indicated, Applicant instead only intended the cancellation of claims 1-21 (as further confirmed by Applicants remarks on p. 4). Accordingly, this error has been corrected, and claims 22-28 are pending.

### ***Response to Arguments***

2. Applicant's argument, see p. 4, paragraph 3, filed January 23, 2004, with respect to the rejection of claims 23 and 24 under 35 U.S.C. §102(b) has been fully considered and is persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, new grounds of rejection are made as detailed below.

### ***Specification***

3. The disclosure is objected to because of the following informalities: The Brief Description of the Drawings and/or the Detailed Description of the Preferred Embodiment sections of the specification refer to individual Figures 8A, 8B, 16A, 16B collectively as Figs. 8 and 16. Although this is proper under 37 CFR §1.74, it is noted that Applicant has referred to

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other, similarly labeled Figures, individually (for example, Figs. 3A and 3B). To promote clarity and consistency in the disclosure, the specification should be amended to correspond to the individual Figures presented. Appropriate correction is required.

4. The use of the trademark JAVA has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

It is noted that Applicant has previously presented arguments traversing this objection, and in response, the objection had been withdrawn. However, it is submitted, that upon closer review, Applicant has not fully complied with the requirements set forth in MPEP §608.01(v). Specifically, the occurrences of trademarks within the specification are not accompanied by generic terminology. To expedite correction of this issue, the Examiner suggests amending the specification to recite, for example, “Java® platform” or “Java® programming language”. Note that in these examples, “platform” and “programming language” provide accompanying generic terminology, describing the context in which the trademark is used. By itself, the trademark JAVA specifies only the source of the so-labeled products, namely Sun Microsystems, Inc.

Applicant is encouraged to review the document, “Sun Trademarks and Logo Usage Requirements,” available online at <URL: <http://www.sun.com/policies/trademarks/>> for more information regarding the appropriate use of JAVA and other trademarks.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 22-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claims 22-28 contain the trademark/trade name JAVA. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a particular object oriented programming environment product and, accordingly, the identification/description is indefinite.

Additionally, Applicants remarks on p. 4 of the reply filed January 23, 2004, “...*although these claims recite Java®, it should be understood that they apply to any object oriented*

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*programming environment*,” further renders the claims indefinite as it is unclear whether Applicant intends the recited trademark to properly refer to Sun Microsystems, Inc. or whether Applicant is attempting to provide an alternate definition of the recited trademark. In the interest of compact prosecution, the Examiner interprets Applicant’s recited “Java® method[s]” as “object oriented programming environment method[s]”. It should be noted that this interpretation is applied only to assign an ascertainable scope to the instant claims, and should not be construed as any interpretation of the meaning of the Sun Microsystems, Inc. trademark JAVA or a suggestion that such a term is generic rather than proprietary.

b. Claim 24 recites the limitation "said internal constant resolution entries" in lines 1-2.

There is insufficient antecedent basis for this limitation in the claim.

c. Claim 25 appears to be missing a transitional phrase, making it unclear how the limitation in the body of the claim further defines the subject matter of the parent claim.

### ***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 22-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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As per claims 22-28, merely claimed as a framework, constitutes a computer program representing a computer listing *per se*, that is, descriptions or expressions of such a program. Such claimed matter is descriptive material *per se*, non-functional descriptive material, and is not statutory because it is not a physical “thing” nor a statutory process, as there are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer program’s functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the program itself is not a process, without the computer-readable medium needed to realize the computer program’s functionality. In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program’s functionality to be realized, and is thus statutory. **Warmerdam**, 33 F.3d at 1361, 31 USPQ2d at 1760. **In re Sarkar**, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV)(B)(1)(a).

***Allowable Subject Matter***

9. Claims 22-28 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. §§ 101, 112, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or fairly suggest preferentially (by default) resolving a called method as cloned versions (within cloned objects – new objects with properties copied from the

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original object) and resolving the called methods to external versions in the event of a version conflict between the cloned and external versions.

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***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited documents provide additional insight into object-oriented cloning and resolution.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric B. Kiss whose telephone number is (703) 305-7737. The Examiner can normally be reached on Tue. - Fri., 7:30 am - 5:00 pm. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam, can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EBK/EBK  
February 12, 2004



**TUAN DAM**  
**SUPERVISORY PATENT EXAMINER**